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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,308	04/19/2004	Yasuhiro Fujiwara	Q91049	1322
23373 759	-		EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			BOLDEN, ELIZABETH A	
			ART UNIT	PAPER NUMBER
WASHINGTON,	DO 2003 /		1755	
SHORTENED STATUTORY F	PERIOD OF RESPONSE	MAIL DATE	DELIVER	Y MODE
3 MONT	THS	02/27/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

		Application No.	Applicant(s)				
Office Action Summary		10/826,308	FUJIWARA ET AL.				
		Examiner	Art Unit				
		Elizabeth A. Bolden	1755				
Period fo	The MAILING DATE of this communication app or Reply	ears on the cover sheet with the	correspondence address				
WHIC - Exte after - If NC - Failu Any	ORTENED STATUTORY PERIOD FOR REPLY CHEVER IS LONGER, FROM THE MAILING DANSIONS of time may be available under the provisions of 37 CFR 1.13 SIX (6) MONTHS from the mailing date of this communication. To period for reply is specified above, the maximum statutory period were to reply within the set or extended period for reply will, by statute, reply received by the Office later than three months after the mailing ed patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATIO 36(a). In no event, however, may a reply be tin will apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	N. mely filed n the mailing date of this communicatio ED (35 U.S.C. § 133).				
Status							
1)🖾	Responsive to communication(s) filed on 26 Se	eptember 2006.					
2a)⊠							
3)	<del>-</del>						
	closed in accordance with the practice under E	x parte Quayle, 1935 C.D. 11, 4	53 O.G. 213.				
Disposit	ion of Claims						
4)⊠	Claim(s) See Continuation Sheet is/are pending	g in the application.					
	4a) Of the above claim(s) is/are withdraw	wn from consideration.					
	Claim(s) is/are allowed.						
	Claim(s) <u>1, 2, 10, 11, 17, 18, 20, 21, 27, 28, 34</u>	<u>1, 35, 41, 42, 44, 45, 51, 52, 58, </u>	<u>59, 61, 62, 68, 69, 75, 76, 7</u>	7 <u>8, 79,</u>			
	2, 93, 95, and 96 is/are rejected.						
· —	☐ Claim(s) is/are objected to. ☐ Claim(s) are subject to restriction and/or election requirement.						
8)	craim(s) are subject to restriction and/o	r election requirement.					
Applicat	ion Papers						
	The specification is objected to by the Examine						
10)🖂	0)⊠ The drawing(s) filed on <u>19 April 2004</u> is/are: a)⊠ accepted or b)□ objected to by the Examiner.						
	Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
4.00	Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.						
11)	The oath or declaration is objected to by the Ex	caminer. Note the attached Office	a Action of John P10-152.				
Priority (	under 35 U.S.C. § 119						
a)	Acknowledgment is made of a claim for foreign  All b) Some * c) None of:  1. Certified copies of the priority document  2. Certified copies of the priority document  3. Copies of the certified copies of the priority document  application from the International Bureau  See the attached detailed Office action for a list	s have been received. s have been received in Applica rity documents have been receiv u (PCT Rule 17.2(a)).	tion No ved in this National Stage				
`	Dec ind diagonal decades of the design for a line	2 202 3ap. 20	•				
Attachmer	nt(s) ce of References Cited (PTO-892)	4) 🔲 Interview Summar	v (PTO-413)				
2) Notic	ce of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail D	Date				
	mation Disclosure Statement(s) (PTO/SB/08) er No(s)/Mail Date	5) Notice of Informal 6) Other:	Patent Application				

Continuation of Disposition of Claims: Claims pending in the application are 1,2,10,11,17,18,20,21,27,28,34,35,41,42,44,45,51,52,58,59,61,62,68,69,75,76,78,79,85,86,92,93,95 and 96.

Art Unit: 1755

#### **DETAILED ACTION**

Any rejections and or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn.

### **Priority**

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

## Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 10, 11, 17, 18, 20, 21, 27, 28, 34, 35, 41, 42, 44, 45, 51, 52, 58, 59, 61, 62, 68, 69, 75, 76, 78, 79, 85, 86, 92, 93, 95, and 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi et al., U.S. Patent Application Publication 2002/0073735 A1.

Hayashi et al. teach an optical glass composition having overlapping ranges of components would instant claims 1, 2, 17, and 18. See paragraphs [0032], [0046], [0047], [0048], and [0049]. Hayashi et al. teach a glass composition having overlapping ranges of refractive index and Abbe number with instant claims 1, 2, 17, and 18. See paragraphs [30] and [0048]. The reference teaches that the optical glass composition is used for a precision press molded article made by press molding procedures. See abstract and paragraphs [0002], [0025]-[0029], and [0092]-[0094].

Hayashi et al. fail to teach any examples or compositional ranges sufficiently specific to anticipate the compositional limitations of the instant claims. However, overlapping ranges have been held to establish *prima facie* obviousness. See MPEP2144.05.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected from the overlapping portion of the ranges taught by the

Art Unit: 1755

reference because overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

## **Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 10, 11, 17, 18, 20, 21, 27, 28, 34, 35, 41, 42, 44, 45, 51, 52, 58, 59, 61, 62, 68, 69, 75, 76, 78, 79, 85, 86, 92, 93, 95, and 96 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of copending Application No. 10/878,618. Although the conflicting claims are not identical, they are not patentably distinct from each other because the composition ranges overlap. Overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 1755

## Response to Arguments

Applicant's arguments filed 26 September 2006 have been fully considered but they are not persuasive.

Applicants' argue that Hayashi et al. does not disclose Bi<sub>2</sub>O<sub>3</sub> as an essential component. This is not deemed persuasive since Hayashi et al. teach that Bi<sub>2</sub>O<sub>3</sub> can be incorporated in to the glass composition in amounts of 0-6 molar %. See paragraph [0049]. This amount overlaps the amount required for the instant glass composition.

#### Conclusion

The additional references cited on the 892 have been cited as art of interest since they are considered to be cumulative to the art relied upon in the rejections above.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Bolden whose telephone number is 571-272-1363. The examiner can normally be reached on 10 am to 6:30 pm everyday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1755

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EAB

20 February 2007